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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/644,651	08/20/2003	Stephen F. Mase	14491.01	5444				
7590 04/28/2009								
Devan V. Padmanabhan DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>GOLDMAN, MICHAEL H</td></tr></table>			EXAMINER	GOLDMAN, MICHAEL H		
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		<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>3688</td><td></td></tr></table>			ART UNIT	PAPER NUMBER	3688	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/644,651

## Applicant(s)

MASE ET AL.

## Examiner

MICHAEL H. GOLDMAN

## Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 13, 15, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13, 15, 21, and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The following is a final action in response to communications received February 24, 2009. Claims 20 and 21 have been added. Claims 1-4, and 10-11 have been amended. Therefore, claims 1-4, 6-15 and 21-22 are pending and addressed below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the server" in line 10. There is insufficient antecedent basis for this limitation in the claim. The Examiner will interpret the limitation as "server".

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-4, 6-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. (20030158777) in view of Katz et al. (7,283,974).

Claim 1 and 11: Schiff et al. discloses the claimed marketing system that matches a customer profile to product/service offers, the marketing system comprising:

a database including customer profile containing information related to a customer's interests in products or services (see page 4 [0077] and Fig 1B discloses client database, portfolio database, RMCS, CRM and Ad Server whereby the databases are linked as a system via the AS, (see [0064]), to produce the equivalent of the database containing all of the elements; also see [0082] for matching function of customer profiles and messages to be sent, examiner construes messages to be offers);

a data base including a plurality of marketing offers related to a customer's interests in specific products and services (see page 1 [0011] lines 5-6 whereby a

number of banners, examiner construes as offers, as an example, are shown to the surfer (customer) as desired by the surfer; also see [0082] lines 8-9 whereby the system may include a Rich Media Campaign Server which builds the files that hold all the relevant information and sends it to the AS to start the process of showing the relevant message(s)/offer(s) to the relevant surfer/user, examiner construes these messages as a plurality of marketing offers);

a server for executing a program operable to match a selected offer of the plurality of product/service offers to the customer profile, the customer profile being a *permission based marketing profile within the server* which continuously communicates through Internet to scan for product /service offers that appear to match the customer profile and provides customer instant communication with a product /service provider and provides customer instant communication with a product / service provider (see FIG 1B, Administration Server (AS) and page 11, claim 1.iii, lines 1-3 whereby *messages*, examiner construes as *marketing offers*, are displayed according to user portfolio, also see Paragraph [0001], lines 3-4 whereby [the] ‘...communication system and method...is useful for the direct communications of a services and goods provider with an Internet surfer...’), examiner interprets the system as implicitly continuously communicating through the internet when the user is connected, and also that instant communication is inherent to the internet, also see [0017], lines 1-3 whereby an Administration Server in which user portfolios are stored and [0018], lines 1-4 whereby every registered user generates and updates one or more user portfolios containing

information relative to Providers the messages (for products and services) of which the user is willing (permission) to view).

However, Schiff fails to disclose the features whereby product/service offers [are] marketed in a variety of web services resident on respective remote serves comprising:

-a server for executing a program operable to match one of the plurality of product/service offers to the custom profile and provides customer instant communication with a product/service provider.

However, Katz et al. (7283974) discloses the feature of a server for executing a program operable to match one of the plurality of product/service offers to the custom profile and provides customer instant communication with a product/service provider (see abstract, lines 1-27, also see column 9, lines 3-12, column 9, lines 50-54, and column 10, lines 6-23, also see column 12, lines 3-11).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Schiff et al. to include the features to match one of the plurality of product/service offers to the custom profile and provides customer instant communication with a product/service provider as taught by Katz et al. in order to provide a seamless access to products/services which match customers preferences.

Claim 2: Schiff et al. and Katz et al. disclose the invention as in claim 1 above. Schiff et al. further discloses the system wherein the program is operable to present product/service offers to each customer, based on the results of the matching agent (see page 11, claim 1.iii, for displaying offer, lines 1-3 and 2.ii for matching from the

database and claim 3.iii for generating one or more messages, examiner construes as marketing offers, and claim 16 wherein a system for messaging over a data messaging makes the invention operable).

Claim 3: Schiff et al. and Katz et al. disclose the invention as in claim 1 above. Schiff et al. further discloses the system wherein the product/service offers are located on a plurality of distributed databases, the database in communication through a communication network (see page 3[0064] lines 1-11 whereby the AS, which contains data relative to all the databases including advertising messages, construed by examiner as marketing offers, whereby the AS may physically be one or a plurality of servers/databases, which may be physically located at the same or at different locations on the net; also see claims 3.ii and 3.iv which discloses selecting messages/marketing offers from a database and transferring the message(s) selected to the sent to one or more selected customers via a server, claim 1.i).

Claim 4: Schiff et al. and Katz et al. disclose the invention as in claim 3 above. Schiff et al. further discloses the system wherein the plurality of databases are located on-site at a company originating at least one of the product/service offers (see page 3 [0064] lines 1-5 and 8-10 which discloses the system wherein the plurality of databases (contained in AS) may be physically located at different locations on the net, construed by examiner to include originating company with at least one of the marketing offers).

Claim 6: Schiff et al. and Katz et al. disclose the invention as in claim 1 above. Schiff et al. further discloses a system including a client computer in communication with the server via a communication network (see Fig 1A whereby client computer, labeled as "U1" with figure of user computer connected to WWW, the communication network via AS, Administration Server).

Claim 7: Schiff et al. and Katz et al. disclose the invention as in claim 6 above. Schiff et al. further discloses the system wherein the client computer includes an applet received from the server (see page 2 [0044] lines 4-7 whereby embedded sources or subroutines, ActiveX control are addressed as one of the preferred embodiments; the ActiveX enables browser is a species of an applet).

Claim 8: Schiff et al. and Katz et al. disclose the invention as in claim 7 above. Schiff et al. further discloses the system wherein the applet is configured to prompt the customer using the client computer to enter the customer profile (see page 5 [0089] lines 1-3 and whereby FIG 2C is an example of portfolio update/registration via a feature embedded into plug-in the browser, examiner construes as an applet, FIG 2C discloses an example of a *prompt* "Add Company" item 200, which initiates an update to portfolio, in the browser window).



Claim 9: Schiff et al. and Katz et al disclose the invention as in claim 8 above Schiff et al. further discloses wherein the applet is further configured to communicate the customer profile to the server (see FIG 2C and [0089] lines 7-9 whereby the plug-in/applet causes the selection of a profile by users to create a URL of the desired provider to be added and further discloses (see [0093] lines 6-12) that the plug-in is configured to communicate the customer profile to AS when the Provider decides it wishes to communicate via the AS to the user plug-ins).

Claim 10: Schiff et al. and Katz et al disclose the invention as in claim 7 above. Schiff et al. further disclose the system wherein the applet is configured to notify the customer at the client computer upon occurrence of a match to the product/service offer (see page 5 [0093] lines 16-17; whereby users store their personal data, construed by examiner as user requesting message/offer, on the plug-ins/applet and see lines 18-19 whereby as soon as the company/providers activate the database of users who have registered, construed by examiner as requesting messages/offers, the AS will contact their plug-ins and transfer requested data/messages/offers to the proper place of the consumers details; also see page 6 [0096] whereby as soon as the user activates his account, he will see a list of companies that want to send him messages/offers via the AS).

Claim 12: Schiff et al. and Katz et al disclose the invention as in claim 11 above. Schiff et al. further discloses communicating the selected offer(s) to the customer/user (see page 2 [0019] lines 1-3 displaying to one or more users on their terminal, *messages*, construed by examiner as advertisements/*offers* according to the information contained in their portfolio/profile).

Claim 13: Schiff et al. and Katz et al disclose the invention as in claim 11 above. Schiff et al. further discloses the method wherein the selected offer/message is communicated to a client computer via a computer network (see [0027] lines 1-3 whereby the *terminal*, can be any device with Internet connectivity or with any other digital media connectivity, e.g. a Personal Computer (PC)).

Claim 15: Schiff et al. and Katz et al disclose the invention as in claim 11 above. Schiff et al. further discloses the method wherein customer profile includes an *identification of the customer* and a preference of the customer (see page 5 [0093] lines 1-2 wherein according to an embodiment of the invention, the user can add any URL that he wished to his portfolio/profile, construed by examiner as customer preference; also see [0093] lines 8-13 whereby users who have asked to register with their AS *ID*, construed by examiner as *customer identification*).

6. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al. (20030158777) in view of Katz et al. (7,283,974) and further in view of Eggleston et al. (6,061,660).

Claim 14: Schiff et al. and Katz et al. disclose the invention as in claim 12 above. Schiff et al. further discloses the feature whereby customer preferences/profiles and matching provider/company messages/offers (see page 1 [0011] lines 5-6 whereby a number of banners, examiner construes as offers, are shown to the surfer (customer) as desired by the surfer).

However, they fail to expressly disclose the step of fulfilling the selected offer with its corresponding company.

Eggleston et al. discloses a system and method for incentive programs and award fulfillment over a computer network (see [54] and abstract [57] lines 1-2) and page 6, column 2, lines 32-35 whereby via a hot computer connected to the network, a client computer of a consumer connected to the network, a sponsor computer connected to a the network sponsor computer, and lines 44-46, via a *fulfillment* automation application program for *associating* a fulfillment method with an award. Examiner construes award fulfillment the same process necessary to receive, service and track orders via Direct Marketing.

Schiff et al. and Katz et al., and Eggleston et al disclose a method for corresponding users and providers for goods and/or services for efficient and effective delivery via use of a network. Therefore, it would have been obvious to one skilled in

the art at the time of the invention to modify the Schiff et al. marketing system that matches a customer profile to marketing offers to include an automated fulfillment method as taught by Eggleston et al. in order to expressly complete the marketing transaction.

7. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiff et al.(20030158777) in view of Katz et al. (7,283,974) and further in view of Official Notice.

Claim 21 and 22: Schiff et al. and Katz et al. disclose the invention as in claims 1 and 11 above, however they fail to disclose the feature presenting the matched product/service offer to the customer in an applet, wherein the server leverages information provided by the customer to individually tailor the offer, and monitoring customer's response to the presented offer and intelligently changing behavior of the applet based upon a customer's response.

However, Examiner takes Official Notice that adaptive/intelligent applets based upon user responses are old and well known in the art (e.g. see Szabo (7181438), column 28, lines 35-47 and column 38, lines 5-14 whereby the intelligent agent applet is self adaptive, meaning that it contains the necessary logic to directly receive information for updating its functionality (behavior)). Therefore, it would have been obvious for a person having ordinary skill in the art at the time of the invention to modify the invention of Schiff et al. to use these old and well known resources. One would have been

motivated to do so in order to provide customers/users with real-time customization of their profiles and related/desired matching offers).

### ***Response to Arguments***

8. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL H. GOLDMAN whose telephone number is (571)270-5101. The examiner can normally be reached on Monday thru Thursday 6:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mhg  
April 23, 2009

/James W Myhre/  
Supervisory Patent Examiner, Art Unit 3688